

REMARKS

Summary

Amended independent Claims 1, 2, 10, 11, 19, and 20 and independent Claims 21 and 27 recite at least one feature not disclosed or suggested by the documents to Narayanaswami et al., Steinberg, and/or Rhoads et al. Therefore, the application is now in allowable form.

Status of the Claims

Claims 1-8, 10-17, and 19-33 are pending in this application, with Claims 1, 2, 10, 11, 19, 20, 21 and 27 being the independent claims.

Claims 1-8, 10-17, and 19-27 have been amended to improve their form and independent Claims 1, 2, 10, 11, 19, and 20 have been amended in response to substantive rejections thereto. Claims 28-33 have been added. Applicant submits that support for these amendments can be found in the original disclosure, and therefore no new matter has been added.

Requested Action

Applicant respectfully requests the Examiner to reconsider and withdraw the outstanding rejections in view of the foregoing amendments and the following remarks.

Applicant also respectfully requests that this Amendment be entered. This Amendment could not have been presented earlier as it was earnestly believed that the claims on file would be found allowable. Given the Examiner's familiarity with the application, Applicant believes that a full understanding and consideration of this

Amendment would not require undue time or effort by the Examiner. Moreover, for the reasons discussed below, Applicant submits that this Amendment places the application in condition for allowance. At the very least, it is believed to place the application in better form for appeal. Accordingly, entry of this Amendment is believed to be appropriate and such entry is respectfully requested.

Substantive Rejections

Claims 1, 3-6, 9, 10, 12-15, 18, and 19 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2003/0011684 A1 (Narayanaswami et al.). Claims 2, 11, and 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,862,218 (Steinberg). Claims 7, 8, 16, 17, 21, 22, 24, 26, and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Narayanaswami et al. and U.S. Patent Application Publication No. US 2002/0080997 A1 (Rhoads et al.).

Response to Substantive Rejections

In response, while not conceding the propriety of the rejections, independent Claims 1, 2, 10, 11, 19, and 20 have been amended. Applicant submits that as amended, these claims are allowable over the cited art for the reasons discussed below. In addition, Applicant submits that independent Claims 21 and 27 are allowable for the reasons discussed below.

A. Independent Claims 1, 10, and 19

These claims now recite the deciding of an embedding mode for defining an embedding method in accordance with a manually selected image sensing mode. By this arrangement, the embedded mode and the image sensing mode can be determined by a single instruction from the user.

In contrast, the document to Narayanaswami et al. is not understood to disclose or suggest the deciding of an embedding mode for defining an embedding method in accordance with a manually selected image sensing mode, as recited by amended Claim 1, 10, and 19. The Office Action cites paragraph [0042] of this document to show this feature. But paragraph [0042] merely states, for example, that “The user of the camera 100 can specify (via the user interface display 126) which of the plurality of parameters are to be watermarked into the digital images (under the control of an applicable software program).” The Office Action also cites paragraph [0034] to show the selecting of an image sensing mode. But this paragraph is merely understood to discuss the use of conventional circuitry 128 for controlling and measuring various parameters such as lens focal length, auto focus distance, shutter speed, etc. As a result, this document is not understood to disclose or suggest the deciding of an embedding mode for defining an embedding method in accordance with a manually selected image sensing mode, as recited in amended independent Claims 1, 10, and 19. For this reason, Applicant submits that the Patent Office has not yet satisfied its burden of proof to show that these claims are anticipated by the document to Narayanaswami et al.

B. Independent Claims 2, 11, and 20

Independent Claims 2, 11, and 20 have been amended to recite the deciding of an image sensing mode in accordance with a manually selected embedding mode. By this arrangement, the embedded mode and the image sensing mode can be determined by a single instruction from the user.

In contrast, the patent to Steinberg is not understood to disclose or suggest the deciding of an image sensing mode in accordance with a manually selected embedding mode, as recited by amended Claims 2, 11, and 20. The Office Action states that this patent discloses the setting of the image sensing mode on the basis of the embedding mode at column 5, lines 1-20 and 38-67. But these portions of the Steinberg patent are merely understood to discuss how an original image acquired by a camera is converted to place a mark on the image. No discussion is understood to be present concerning the deciding of an image sensing mode in accordance with a manually selected embedding mode, as recited in amended independent Claims 2, 11, and 20.

For this reason, Applicant submits that the Patent Office has not yet satisfied its burden of proof to show that these claims are anticipated by the Steinberg patent.

C. Claims 21 and 27

Independent Claims 21 and 27 recite, in part, determining, in accordance with the selected image sensing mode, whether to activate an embedding step or embedding means.

In contrast, neither the document to Narayanaswami et al., nor the patent to Rhoads et al. is understood to disclose or suggest the concept of determining, in accordance with the selected image sensing mode, whether to activate an embedding step or embedding means,

as recited by Claims 21 and 27. Rather, paragraphs [0021] and [0023] of the Rhoads et al. patent are merely understood to disclose the setting of one of three watermarking modes using a user interface, while, the Office Action admits that the document to Narayanaswami et al. does not describe the use of a determination means to determine whether or not to embed data.

To establish a prima facie case of obviousness under MPEP §2142 and § 2143, the Patent Office must cite art showing each of the claimed features. But here, as noted above, neither the document to Narayanaswami et al., nor the patent to Rhoads et al. is understood to disclose or suggest the concept of determining, in accordance with the selected image sensing mode, whether to activate an embedding step or embedding means, as recited by Claims 21 and 27. Therefore, the Patent Office has not yet established a prima facie case of obviousness against these claims.

Dependent Claims

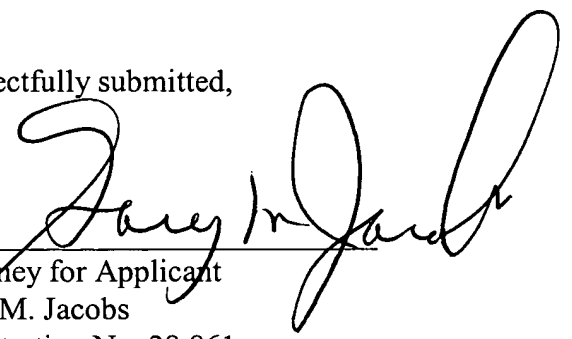
The dependent claims are allowable for the reasons given for the independent claims and because they recite features that are patentability in their own right. Individual consideration of the dependent claims is respectfully solicited.

Conclusion

In view of the above amendments and remarks, the claims are now in allowable form. Therefore, early passage to issue is respectfully solicited.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



Attorney for Applicant
Gary M. Jacobs
Registration No. 28,861

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200
BLK/lmj